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Docket 84199F-P
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Richard W. Bauer, et al

**A BOTTLE AND BOTTLE
CLOSURE ASSEMBLY**

Serial No. 10/080,118

Filed February 21, 2002

Group Art Unit: 3727

Examiner: Lien M. Ngo

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

APPEAL BRIEF TRANSMITTAL

Enclosed herewith in triplicate is Appellants' Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. 1.192

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APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1-4, 6, 8, 9, 11-13, 16-19, 21, 23, 24, 26-28 and 30 which was contained in the Office Action mailed February 25, 2004.

A timely Notice of Appeal was filed June 2, 2004.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1-4, 6, 8, 9, 11-13, 16-19, 21, 23, 24, 26-28 and 30 have been rejected.

Appendix I provides a clean, double spaced copy of the claims on appeal.

Status Of Amendments

All amendments have been entered and the claims stand as indicated in Appendix I.

Summary Of The Invention

The present invention is directed to cap member 10 for use on a bottle 12 having a sealed member 26 placed over the outlet of the bottle. The cap member has an annular skirt 28 (see Fig. 2). There is also provided a plurality of rupture members 48 that punctures the seal upon engagement with an external probe 30 (see Fig. 6). Each of the plurality of rupture members have a shape that will substantially clear the seal 26 at the outlet 24 for allowing quick and easy egress of solution from the bottle while the external probe is present in the bottle. The rupture members also have a connecting hinge 50 (see Fig. 4) that allows the

rupture members to pivot approximately 90° with respect to a plane parallel to the outlet.

Issues For Review By The Board

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 16-19, 21, 23, 24, 26-28 and 30 fail to comply with the written description requirement under 35 USC § 112.
2. Whether claims 1-4, 6, 8, 9, 11-13, 16-19, 21, 23, 24, 26-28 and 30 fail to particularly point out and distinctly claim the subject matter which Applicant regards as the invention under 35 USC § 112.
3. Whether claims 1, 4, 6, 8, 9, 11-13, 16-19, 21, 23, 24, 26-28 are unpatentable under 35 USC § 103(a) over Uchiyama (Publication US 2003/42257) in view of U.S. Patent 4,770,305 to Su.

Grouping Of Claims

- | | |
|-----------|---|
| Group I | Claims 1, 2, 3, 4, 8, 9, 13, 16, 17, 18, 19 and 28 stand together as a group. |
| Group II | Claims 6 and 21 stand together as a group. |
| Group III | Claims 3, 7, 11, 12, 14, 15, 22, 23, 24, 26, 27, 29 and 30 stand together as a group. |

Arguments

The Rejection

Group I - Claims 1, 2, 3, 4, 8, 9, 13, 16, 17, 18, 19

- A. The Examiner in Paragraph 3 of the Official Action rejected claims 16-19, 21, 23, 24, 26-28 and 30 under 35 USC § 112, first paragraph as failing to comply with the written description requirement.

The Examiner, in paragraph 1 of the official action, has objected to the drawings in that it must show every feature of the present invention. In particular the Examiner states that there is no seal having an annular skirt for securing cap member to the neck portion in claim 16. Claim 16 states that the cap

member has an annular skirt. The specification at page 5, lines 3-5, and also as illustrated by Figures 3 and 4 provides support for this portion of the claim.

The Examiner, in paragraph 3, also rejected claims 16-19, 21, 23, 24, 26-28 and 30 under 35 USC § 112 first paragraph for failing to comply with the written description requirement. The Examiner states that "said seal having an annular skirt for securing said cap member to said neck portion" in claims 1 and 16 are not described and that "internal threads provided on said annular skirt" in claim 18 is also not described. As previously discussed, the cap member is provided with a skirt for securing the cap member to the bottle. The specification as amended at page 5 lines 4-6 clearly provides such support. The specification states "The internal surface 38 of the annular skirt 34 is provided with internal threads 40 for engaging external threads 42 on the outer surface of the upper end 36 of said bottle..." Figure 3 illustrates the described structure. Thus, it is respectfully submitted the claims clearly have support in the description of the specification as currently set forth.

The Examiner in paragraph 5 of the Official Action rejected claims 1-4, 6, 8, 9, 11-13, 16-19, 21, 23, 24, 26-28 and 30 under 35 USC § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regard as the invention. The Examiner seems to be arguing whether or not the external probe is a part of the claimed invention. In this regard, it is normal to provide functional limitations describing specific functions of a part. MPEP 2173.05(g) clearly provides and states that there is nothing inherently wrong with defining some part of an invention in functional terms. This does not mean that those functional terms become a part of the positive claimed structure, but merely define the context in which it is used. In this regard the functional language that is provided in the claims just merely describes the function of the rupture members when it engages an external probe. Thus, the probe is not a part of the claimed invention, but merely describes the functional characteristics of the various elements when it engages a probe.

Accordingly, it is respectfully submitted that the rejected claims are not indefinite for failing to particularly point out and claim the subject matter which Applicant regards as the invention.

The Examiner, in paragraph 7 of the final Official Action, rejected claims 1-4, 6, 8, 9, 11-13, 16-19, 21, 23, 24, 26-28 and 30 under 35 USC § 103(a) as being unpatentable over Uchiyama in view of Su.

Applicant respectfully submits that Uchiyama fails to teach or suggest the invention as taught by Applicant. The Uchiyama reference is directed to a structure that is totally apart and distinct from the present invention. In particular, there is provided a sealing member 10 that provides the sealing function of the bottle. The cited reference refers to "packing member 10" that is mounted to the cap 12. The packaging 10 includes a sealing disc 34. The sealing disc 34 is formed in substantially disc shape having a constant thickness L. See page 5, line 81. A plurality of arcuate thin portions 46 are provided in the disc portion 34 (see paragraph 82). Grooves 50 are provided in the surface 34A of the sealing disc 34C (see paragraph 84). Figures 10A and 10B, 11A and 11B, 12A and 12B illustrate the puncturing of the disc portion 34. Prior to this, the disc portion provides the seal. There is no teaching or suggestion of providing rupture members which puncture a separate seal as taught and claimed by applicant. Quite the contrary, this reference teaches away from providing a separate seal as it is the disc member 34 that provides the seal between the contents of the bottle and allowing dispensing there through.

The '305 reference, as applicants discussed in the previous response, is directed to providing a bottle cap that has projections that when the cap is depressed will engage the seal. However, the cap merely discloses a cap having a convex top 21 which is depressed to lower the projection to break the foil 3. However, it does not teach or suggest the providing of rupture members that engage the seal upon engagement with an external probe and allow dispensing while the external probe is in the bottle. The Su reference includes a projection 29 that is used to push open the cap. The cap is removed for dispensing of fluids (see column 2, lines 35-38). Further, Su does not teach or suggest the rupture member having a hinge member allowing rupture members to pivot approximately 90° with respect to a plane parallel to the outlet. This allows external probe to be placed within the bottle and allow easy egress of the fluid while the probe is within the bottle.

In order for one reference to be combined with another reference there must be some teaching, suggestion or motivation to do so. In order to combine references there must be an objective evidence showing a suggestion, teaching or motivation to combine the prior art references. The combining of reference can only be done if there is some suggestion or incentive to do so. The CAFC in *In re Lee* 277 Fed 3rd 1338 (61 USPQ 2nd 1430) 2002 at page 1434 stated:

“(the examiner can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references’)”.

As previously discussed, the Uchiyama reference teaches away from providing a separate seal as taught and claimed by applicant. In order to combine the references there would have to be some reason to do so. Since the Uchiyama reference is directed to eliminating a seal, there would be no reason to make the modification as suggested by the Examiner. Quite the contrary, this is a teaching away of combining two references as the ‘305 reference clearly requires the providing of a separate seal. Furthermore, neither one of the references teach or suggest that the plurality rupture members having a connecting hinge that allows rupture members to pivot approximately 90° with respect to the plane of said outlet. As previously discussed, claimed structures allow easy egress of the fluid while the probe is within the bottle.

Group II - Claims 6 and 21

- B. Claims 6 and 21 are dependent claims and are dependent upon independent claims 1 and 16 respectively. Each of these dependent claims further go on to set forth that the rupture members have a cutting edge for assisting the rupturing seal.

Referring to Figs. 11a and 11b there is illustrated the cutting edge 357 which further assists in breaking of the seal. There is no teaching or suggestion that the rupture member has a cutting edge as taught and claimed by Applicant. The prior art Uchiyama reference does not teach or disclose any such

cutting edge and the Su reference merely discloses blades 200 tapered to an apex 24. The blades 200 are nothing more than a projecting members. There is no teaching or suggestion of providing a cutting edge as taught and claimed by Applicant. Thus, the prior art fails to teach or suggest the providing of such and therefore these dependent claims are patentably distinct for this additional reason.

Group III **Claims 3, 11, 12, 14, 15, 22, 23, 24, 26, 27, 29 and 30**
C. The claims of group 3 are directed to providing more detailed features of the rupture member. These claims are dependent claims which depend at least ultimately upon independent claims 1 or 16.

These claims include additional structural features not taught or suggested by the prior art. In particular claims 7 and 22 disclose that the rupture member has a rib 410 which assists in moving the rupture member against the inside surface of the neck. There is no teaching or suggestion of providing such a rib in either of the references cited. Additionally, dependent claims 11, 12, 14, 15, 22, 23, 24, 26, 27, 29 and 30 discuss particular dimensional features and structure not taught or suggested. Claims 11, 12, 14, 15, 24, 25, 27, 29 and 30 discuss various dimensional features of the hinge slot, hinge radius, thickness of the rupture member and space between the rupture members. These spaces with hinge member constructions are important in allowing the rupture members to properly operate. The specific dimensional features are not taught or suggested by the prior art and therefore are patentably distinct for this additional reason.

The structural features are not mere change in size but are important aspects in assuring that the rupture members function in a manner that they break the seal and yet allow the flow of fluid from the bottle.

Summary

In summary, Applicant respectfully submit that the present invention is patentable over the cited art.

Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance in the present application.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Frank Pincelli", is written over a solid horizontal line.

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